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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,513	06/12/2001	Mark W. Slipp	495142000100	7749
20872 7590 06/05/2007 MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			EXAMINER ENGLAND, DAVID E	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/881,513

**Applicant(s)**

SLIPP ET AL.

**Examiner**

David E. England

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5, 6, 24, 25 and 27 - 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 24, 25 and 27 - 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Claims 5, 6, 24, 25 and 27 – 35 are presented for examination.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5, 6, 24, 25 and 27 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky (6300947) in view of Tso et al. (6092191) (hereinafter Tso).

4. Referencing claim 5, as closely interpreted by the Examiner, Kanevsky teaches a method for inserting second content from a second computer into first content requested over the Internet by a user via an application running on a first computer the second content sent by the second computer over the Internet to the application running on the first computer for receipt by the user, the method comprising:

5. intercepting a request on an intermediate computer to establish a connection with the second computer sent by the first computer, (e.g., col. 10, line 36 – col. 11, line 24);

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6. establishing a first connection between the intermediate computer and the first computer and establishing a second connection between the intermediate computer and the second computer, (e.g., col. 10, line 36 – col. 11, line 24);
7. receiving a request in the intermediate computer for the first content sent by the user via the application running on the first computer, (e.g., col. 10, line 36 – col. 11, line 24);
8. sending the request for the first content from the intermediate computer to the second computer, (e.g., col. 10, line 36 – col. 11, line 24);
9. receiving in the intermediate computer a response from the second computer containing the first content, (e.g., col. 10, line 36 – col. 11, line 24); and
10. sending the first content and the second content from the intermediate computer to the application running on the first computer for receipt by the user, (e.g., col. 10, line 36 – col. 11, line 24),
11. wherein the second content is provided to the first computer independent of a display size of the first computer, (e.g., col. 11, lines 14 – 64, “cookies”).
12. searching for a pre-determined rule for insertion based on the information contained in the request for content sent by the application running on the first computer to the second computer wherein the second content is sent to the application running on the first computer only if a pre-determined rule for insertion indicates that second content should be sent to the first computer, (e.g., col. 10, line 36 – col. 11, line 24), but does not specifically teach prior to searching for a pre-determined rule for insertion:
13. checking IP address information associated with the request;

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14. if the IP address information does not match pre-determined IP address information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion.

15. Tso teaches prior to searching for a pre-determined rule for insertion:

16. checking device information associated with the request, (e.g. col. 5, line 62 – col. 6, line 8, “*GetObject()*” & col. 9, line 66 – col. 10, line 36, “*Upon determining that network client 12 is non-enabled...* ”);

17. if the device information does not match pre-determined device information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion, (e.g. col. 5, line 62 – col. 6, line 8, “*GetObject()*” & col. 9, line 66 – col. 10, line 36, “*Upon determining that network client 12 is non-enabled...* ”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Tso with Kanevsky because if a user’s device is new and there is no section in a database or storage device that would have rules for the device than it would be obvious to forward the requested content because there would be no rules for the device if there is nothing found about the device. Tso also anticipates the use of an IP address in a system as seen in the beginning of column 10, and how it is not advantageous to use addresses because of the possibility of a first user disconnecting and a second user reconnecting and using the first user’s IP address. Therefore, it was well known in the art that one could use IP addresses to determine if a user was recorded in the system. Tso remedies this by utilized protocols to aid in determining if the user is enabled or non-enabled to receive edited web page information.

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18. As per claim 27, as closely interpreted by the Examiner, Kanevsky teaches a method for delivering second content to a user via an application running on a first computer who has requested first content over the Internet from a second computer the second content received by the application running on the first computer before the first computer receives the first content, the method comprising:

19. intercepting a request to establish a connection with the second computer sent by the application running on the first computer, (e.g., col. 10, line 36 – col. 11, line 24);

20. establishing a connection between the first computer and the intermediate computer, (e.g., col. 10, line 36 – col. 11, line 24);

21. establishing a connection between the second computer and the intermediate computer, (e.g., col. 10, line 36 – col. 11, line 24);

22. delivering the second content to the application running on the first computer for receipt by the user and via the intermediate computer, (e.g., col. 10, line 36 – col. 11, line 24);

23. receiving in the intermediate computer the first content from the second computer, (e.g., col. 10, line 36 – col. 11, line 24); and

24. sending the first content to the application running on the first computer, (e.g., col. 10, line 36 – col. 11, line 24), but does not specifically teach receiving in the intermediate computer a first request for the first content sent by the application running on the first computer, wherein the intermediate computer does not send the first request for the first content to the second computer;

25. receiving in the intermediate computer a re-request from the first content from the application running on the first computer, wherein the re-request for the first content from the

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application running on the first computer occurs after delivery of the second content to the first computer;

26. sending the re-request for the first content from the intermediate computer to the second computer after delivery of the second content to the first computer, wherein establishing the connection between the second computer and the intermediate computer occurs in response to the re-request for the first content from the first computer;

27. Tso teaches receiving in the intermediate computer a first request for the first content sent by the application running on the first computer, wherein the intermediate computer does not send the first request for the first content to the second computer, (e.g., col. 13, lines 36 – 67, “*caching system*”);

28. receiving in the intermediate computer a re-request from the first content from the application running on the first computer, wherein the re-request for the first content from the application running on the first computer occurs after delivery of the second content to the first computer, (e.g., col. 14, lines 21 – 64, “*not in cache*”);

29. sending the re-request for the first content from the intermediate computer to the second computer after delivery of the second content to the first computer, wherein establishing the connection between the second computer and the intermediate computer occurs in response to the re-request for the first content from the first computer, (e.g., col. 14, lines 21 – 64, “*not in cache*”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Tso with Kanevsky because utilizing a proxy cache system enables a user to have quicker access to HTTP documents for frequent use as opposed to continually accessing

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web servers for content that is frequently requested. Not having a cache system could add latency to a system.

30. The teachings of claims 6, 24, 25 and 28 – 35 can be found in the same cited areas as stated above and are rejected for similar reasons.

### ***Response to Arguments***

31. Applicant's arguments with respect to claims 5, 6, 24, 25 and 27 – 35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. a. Bickmore et al. U.S. Patent No. 6857102 discloses Document re-authoring systems and methods for providing device-independent access to the world wide web.

34. b. Whitledge et al. U.S. Patent No. 6925595 discloses Method and system for content conversion of hypertext data using data mining.

35. c. Bechtolsheim et al. U.S. Patent No. 6377577 discloses Access control list processing in hardware.



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36. d. Birrell et al. U.S. Patent No. 6009462 discloses Replacing large bit component of electronic mail (e-mail) message with hot-link in distributed computer system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912.


The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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